

REMARKS

Claims 1-11 and 16 are pending with claims 12-15 cancelled and claim 16 added by this paper.

Claim Rejections Under 35 U.S.C. §112, first paragraph:

Claims 1-15 stand rejected as allegedly being non-enabling to one skilled in the art. Particularly, the action alleges that the present specification does not provide a specific description of a micromixer. Applicants respectfully traverse these assertions.

The teaching of the manner of making and using an invention using terminology describing and defining the subject matter *must* be taken as complying with an enablement requirement *unless* there is a reason to doubt the objected truth of the statements contained therein. *See, e.g., In re Marzocchi and Horton*, 169 USPQ367 (CCPA 1971). Applicants respectfully submit that the action does not establish that one of skill in the art would not be able to use a micromixer in the context of the present invention.

Furthermore, the present specification at page 6, lines 28-34 cites five published German Patent Applications. Attached hereto for the Examiner's convenience are three U.S. Patents corresponding to three of these German Patent Applications. Applicants respectfully submit that this further confirms that one skilled in the art having knowledge of these publications would be able to use a micromixer in the context of the present invention without undue experimentation. Consequently, Applicants respectfully submit that these rejections should be withdrawn.

Claim Rejections Under 35 U.S.C. §112, second paragraph:

Claims 1-15 stand rejected as allegedly being indefinite. Applicants respectfully traverse these rejections.

With respect to the allegations that the term "micromixer" in claim 1 is indefinite, Applicants respectfully submit that the breadth of a claim is not to be equated with indefiniteness (*In re Miller*, 441F.2d689, 169 USPQ 597 (CCPA 1971). There is no requirement that a claimed invention must include all elements disclosed in the specification.

In addition, Applicants respectfully submit that the Examiner has not established a *prima facie* case that one skilled in the art would not understand the claimed invention. To the contrary, Applicants respectfully submit that one of ordinary skill would readily ascertain the metes and bounds of the term "micromixer" from, e.g., the five published German Applications disclosed in the specification. See, e.g., column 1, lines 3-26 of U.S. Patent 6,457,854.

With respect to claim 3, there is nothing inconsistent about the defining the formulation as being subsequently stirred. Applicants respectfully submit that this rejection should be withdrawn.

With respect to the rejections of claims 2 and 3, Applicants have amended claim 2 to replace "if necessary" with --optionally-- and have rewritten claim 3 to define the micromixer as being temperature controlled. Consequently, Applicants respectfully submit these rejections should be withdrawn, and moreover, these amendments do not narrow the scope of these claims.

With respect to claims 4 and 5, Applicants have rewritten these claims into active voice. Applicants respectfully submit that rewriting these claims into active voice does not narrow the scope of these claims. Moreover, this rephrasing of the claim has been done for clarification. With respect to the allegations that one cannot form an emulsion with just an oil phase, Applicants respectfully submit that both claims 4 and 5 define mixing one or more liquid components with one or more oils or fats. One of the liquid components, could be, for example, water. Consequently, Applicants respectfully submit that one of skill in the art would readily understand the metes and bounds of these claims as well.

With respect to claims 10-11, there is no "pumping means" defined in the claims. With respect to the allegations that it is unclear where the pumping is, Applicants again submit that the breadth of a claim is not to be equated with a definiteness.

With respect to claims 12, 14 and 15, Applicants respectfully submit that these claims have been cancelled. Therefore, Applicants respectfully submit that all of the above rejections be withdrawn.

Claim Amendments:

Claims 1-11 have been amended to insert an article "a" before the term "process"; rewritten the plural "formulations" into the singular --formulation--, and adding a corresponding article --a--; replace the term "characterized in that" with -- wherein--, --comprising--, or --further comprising--; and if applicable, rewriting the claims in active voice. In addition, superfluous language "owing to the pressure which builds [sic: building, in claim 6] up due to" has been replaced with --by the pumping pressure-- in claims 6, 7, 10 and 11. Applicants respectfully submit that none of these amendments narrow the scope of the claims and are merely done for clarification.

Prior Art Rejection:

Claims 12-15 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,658,578. Applicants have cancelled these claims, thereby removing this ground of rejection.

Claims 1-3, 6, 8 and 13 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by, and claims 4-5, 7 and 9-11 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over GB 2145107 (GB). Applicants respectfully traverse these rejections.

GB fails to teach or suggest a micromixer. Applicants respectfully traverse the action's assertion that a mixing chamber as disclosed in GB can be construed as a micromixer as defined by the present invention. Rather, GB discloses a mixing chamber to receive two components. Using propellants, the two components are turbulenty mixed in the chamber. See page 4, lines 33-53 and page 5, lines 10-57. GB fails to teach or suggest that the mixing chamber is a micromixer, and furthermore, there is no teaching or suggestion that the mixing chamber has communicating channels to allow multiple mixing conditions (relevant to claim 1). Rather, GB discloses mixing the components in turbulent conditions.

Furthermore, multiple mixing conditions of the present invention caused by the communicating channels leads to several significant improvements. Particularly, easily obtainable very small particle size emulsion droplets (microemulsions), a significantly improved homogenous

droplet sized distribution, a homogenous distribution of all ingredients with respect to the achieved phase, and a reduction in the amount of emulsifiers required. See present specification at e.g., page 3, line 35- page 4, line 2; page 4, lines 4-7; page 6, line 20; and page 6, line 23.

Consequently, Applicants respectfully submit that these rejections should be withdrawn.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indiect below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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